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EXAMINER	
GRAHAM, M	
ART UNIT	PAPER NUMBER
3711	<i>23</i>
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 08/926,346

Filing Date: 09/05/97

Appellant(s): Sullivan

Richard M. Klein
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 2/9/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because a ball of the description given in the "Summary of the Invention" is not disclosed in the originally filed specification. The values recited by the applicant as being found on the various pages are simply not present. As an example the core diameter found on page 35, lines 12-14 is "about 1.495 to about 1.575 inches" (37.973mm to 40.005mm) and not "at least 29mm "1.1417" inches as asserted in the "Summary of the Invention". Applicant's "at least 29mm" recitation in the "Summary of the Invention" includes the values from 29mm through at least 37.973mm and these values are not found in the passage cited by the applicant or anywhere else in the specification.

(6) Issues

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The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The issue at hand in this application is whether claims 1-8 meet the requirements of 35 U.S.C. 112, first paragraph as it pertains to new matter situations.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because no reasons are given as to why claims 2 and 4 are separately patentable. Therefore claims 2 and 4 are considered to stand or fall with claim 1.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office action, Paper No. 13.

(11) *Response to Argument*

In response to appellant's initial comments it is first noted that the time at which the grounds of rejection was first present is not an appealable issue. However, as previously explained to appellant, the office regrets the delay in the recitation of the rejections advanced in the 12/13/99 rejection. As has been discussed with appellant, the retirement of the senior

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examiner in the art, misfiling of papers between various of appellant's applications and the dispersal of appellant's large volume of applications with overlapping subject matter to various examiners previously not working in the art contributed to the delay. Additionally however, appellant's lack of communication between in-house and out-of-house counsel resulting in duplicate applications and duplicate claims and lack of clarity as to which cases appellant considered to be related has contributed to the problem. The delay in the citation of the grounds of rejection based on 35 U.S.C. 112 first paragraph though has no bearing on its applicability.

Regarding appellant's substantive arguments, the test for determining compliance with the written description requirement in 35 U.S.C. 112 first paragraph is whether the disclosure as originally filed reasonably conveys to the artisan that appellant had possession at that filing time of the subject matter now claimed. In re Kaslow 217 USPQ 1089. That one skilled in the art might realize from reading the specification that applicant's proposed interpretation may be one possibility among others, is not a sufficient indication to that person that such a possibility satisfies the test for compliance with the description requirement. (Emphasis added) See In re Barker, 194 USPQ 470. Thus, a disclosure cannot be said to "reasonably convey" that the artisan had possession of the claimed subject matter if it is but one possibility among others. Without a showing that the specification disclosed definitively what the appellant now states was intended, to the exclusion of other possibilities, the rejection under 35 U.S.C. 112 first paragraph must stand.

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Appellant's response to the claim 1 rejection is that although the appellant is claiming a range from 29 mm to infinity, and that the lowest value the disclosure recites is 39.243 mm he has nevertheless disclosed the range which includes 29mm - 39mm. The 39 mm value recited by the appellant is approximately 30% larger than the lower end of the claimed range and nothing in the specification indicates that appellant intended to include anything below 39.243 mm as opposed to other possibilities. Thus, appellant cannot have been said to "reasonably convey" the 29mm-39mm range now being claimed.

The same logic applies to the range of the specific gravity of the core between 1.4 and 1.155. Appellant has simply given no indication that specific gravities in this range were intended to be part of his invention among other possibilities. To come back after the fact and copy a patent which was interested in those ranges is the essence of new matter.

Regarding the lower limit of the intermediate thickness, appellant is correct in that this was part of the original disclosure. However, appellant's disclosed ball is not inclusive of thicknesses above 2.54mm whereas that being claimed is. Appellant's assertions with regard to the '852 patent are conclusive of nothing. The application which matured into the '852 patent disclosed the claimed range, "at least 1 mm" whereas appellant's application did not. Appellant is reminded that the original disclosure includes what was included in the original specification, abstract, claims, and drawings and not merely the original specification. Moreover, even were it the case that the '852 patent contained new matter, the proper course of action would not be to issue a second application which included new matter.

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Concerning the specific gravity of the intermediate layer, the originally filed disclosure is not inclusive of the range between 1.2 and .97 as is now being claimed. Appellant's exhibit A (resubmitted as exhibit B) does not address any specific gravities between 1.2 and .99. Appellant's assertion that these exhibits reasonably convey a specific gravity of "less than 1.2" is not supported. Why would these exhibits support "less than 1.2" more than "less than 1.0?" Appellant's 1.2 figure for the upper end of the range is but one possibility among many with no support for any particular value. The 1.2 value derives solely from the '852 patent. Concerning what is included in the '852 patent's original disclosure note the examiner's above comments.

With regard to the hardness of the intermediate layer, the originally filed disclosure is not inclusive of the range between 85 and 95. Appellant asserts that the recitation in the specification of 96 or 98 means "at least 85". Again there is not support for this assertion and it is but one possibility among others.

Concerning the appellant's outer cover thickness, the largest cover thickness originally disclosed was 1.27 mm which is *not even half* of the now claimed 3 mm.

In response to appellant's claim 3 arguments, the appellant freely admits that there would have been possibilities other than that which he now claims. Moreover, how would one know that appellant intended the entire range as opposed to only an upper end of the range? Even using appellant's logic, at best a range of 60-80 on JIS C scale has been disclosed. Concerning the core hardness no support whatsoever is offered for the claimed range.

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Appellant's entire argument is that it would have been "inherent." The question is, "Inherent based on what?"

Regarding the claim 5 arguments, appellant has provided no evidence that a lower limit of 29 mm was disclosed to the exclusion of other possibilities. Why would 35.052mm reasonably convey 29mm and not 31mm as the lower limit on the core diameter?

Regarding claim 6, appellant has still provided no evidence that values above .234 or below .164 were intended as is now claimed. Thus, values outside of this range represent new matter. Even were values outside this range intended how would one know what they were?


Likewise, with regard to claims 7 and 8, appellant has still provided no evidence that values as high as the upper end of the claimed ranges, or as low as the lower end of the claimed ranges were intended as is now claimed. Thus, values such as these represent new matter. The values now being claimed are only one possibility among an infinite number that appellant might have intended. Appellant focuses on the fact that he has disclosed values within these ranges. However, that is not the issue. The issue is what values other than those disclosed are reasonably conveyed. To this end appellant can provide no evidence that he intended values as high or as low as those now claimed.

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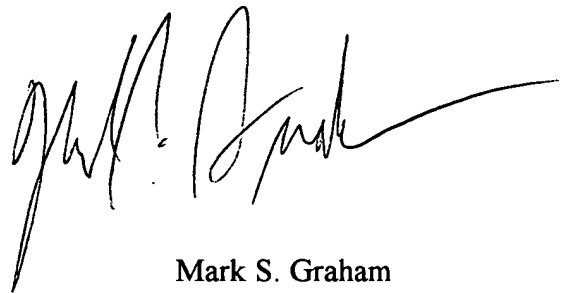
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Appeal Conferees:

Steve Wong 

Stephen Blau 



Mark S. Graham

April 20, 2001

Mark S. Graham
Primary Examiner